

3626

PATENT  
5053-27900

#16  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/603,308  
Filed: June 23, 2000  
Confirmation No.: 1777  
Inventors:  
Wolfe et al.

Title: SYSTEM AND METHOD  
FOR EXTERNALIZATION  
OF FORMULAS FOR  
ASSESSING DAMAGES

§ Examiner: V. Frenel  
§ Art Unit: 3626  
§ Atty. Dkt. No: 5053-27900

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8	
DATE OF DEPOSIT: 12.19.03	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail on the date indicated above and is addressed to:	
§	Commissioner for Patents Alexandria, VA 22313-1450
§	
§	B. Gail Ballard

REQUEST FOR WITHDRAWAL OF HOLDING OF ABANDONMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

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Applicant hereby requests withdrawal of the holding of abandonment of the above-referenced application.

On December 2, 2003, a Notice of Abandonment for the above-referenced application was sent to Applicant's undersigned attorney. The Notice of Abandonment indicated that the

above-referenced application had gone abandoned due to failure to timely or properly reply to a Final Office Action mailed on April 18, 2003.

Applicant filed an Amendment and Response to the Final Office Action on June 18, 2003. *See Exhibit A.* An Advisory Action was mailed on June 23, 2003. *See Exhibit B.* The Advisory Action acknowledged the receipt of the Amendment and Response to the Final Office Action mailed June 18, 2003. The Advisory Action stated that “THE REPLY FILED 23 JUNE 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.” *See Exhibit C.* In Item 7, the Examiner also indicated that for the purposes of appeal the proposed amendments would be entered. *See Exhibit B.*

Applicant mailed a Request for Continued Examination on August 18, 2003 with a Fee Authorization. *See Exhibit C.* As indicated on the postcard, *see Exhibit D,* the USPTO received the Request for Continued Examination and Fee Authorization on August 21, 2003. Applicant electronically filed an Information Disclosure Statement on August 19, 2003, as evidenced in the Acknowledgment Receipt. Copies of both are attached as Exhibit E. Applicant also mailed an Information Disclosure Statement on August 20, 2003. *See Exhibit F.* As indicated on the postcard, *see Exhibit G,* the USPTO received the Information Disclosure Statement mailed August 20, 2003 on August 22, 2003.

A Notice of Improper Request for Continued Examination was mailed on August 28, 2003. *See Exhibit H.* The Notice of Improper Request for Continued Examination stated that

“[t]he request was not accompanied by a submission as required by 37 C.F.R. 1.114.” Applicant submits that the Request for Continued Examination was accompanied by an appropriate submission.

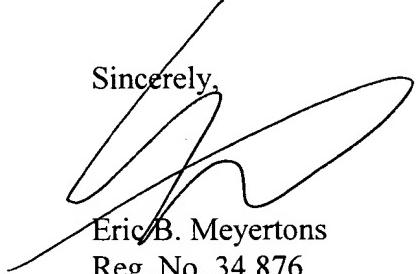
37 C.F.R. 1.114 (a) permits an applicant to “request continued examination of the application by filing a submission and the fee set forth in § 1.17(e).” “A submission as used in this section includes, but is not limited to, an information disclosure statement...” 37 C.F.R. 1.114 (c). Applicant submits that the information disclosure statements filed were appropriate submissions under 37 C.F.R. 1.114. Applicant respectfully submits that the Request for Continued Examination was not improper since it included a submission and the requisite fee.

Applicant then received a Notice of Abandonment mailed December 2, 2003. Applicant submits that the Notice of Abandonment is improper. Applicant submitted a Response to the Final Office Action mailed April 18, 2003 and a Request for Continued Application with the requisite submission and fees, as indicated above.

Applicant respectfully requests entry of this Request in the application and requests that the Notice of Abandonment be withdrawn.

Inventors: Wolfe et al.  
Appl. Ser. No.: 09/603,308  
Atty. Dkt. No.: 5053-27900

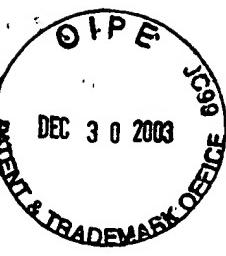
Applicant believes that no fees are required with the filing of this paper. Should any fees be required, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 50-1505/5053-27900.

Sincerely,  
  
Eric B. Meyertons  
Reg. No. 34,876

Attorney for Applicants

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Date: \_\_\_\_\_



~~Exhibit A~~ ~~RECEIVED~~

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PATENT

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**CERTIFICATE OF MAILING  
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Gail Ballard

**AMENDMENT; RESPONSE TO OFFICE ACTION MAILED APRIL 18, 2003**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Please amend the above-captioned application as follows.

**Amendment to the Claims:**

1. (Currently amended) A system comprising:  
a rules engine which is operable to assess a value of an insurance claim as a function of a plurality of rules, wherein said plurality of rules comprise formulas to assess said value of said insurance claim;  
a database which stores formula data, wherein said database is separate from said rules engine; and  
a translator program which is operable to read said formula data from said database and transform said formula data into said formulas of said plurality of rules.
2. (Cancelled)
3. (Previously amended) The system of claim 1,  
wherein said formula data is stored in a tabular format in said database.
4. (Previously amended) The system of claim 1,  
wherein said formula data comprises alphanumeric values stored in said database.
5. (Previously amended) The system of claim 1,  
wherein said formulas are configured to be updated by updating said formula data stored in said database.
6. (Previously amended) The system of claim 1,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a formula identifier.
7. (Previously amended) The system of claim 1,

wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a sequence number.

8. (Previously amended) The system of claim 1,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a section description.
9. (Previously amended) The system of claim 1,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a page identifier.
10. (Previously amended) The system of claim 1,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a prompt identifier.
11. (Previously amended) The system of claim 1,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises an answer identifier.
12. (Previously amended) The system of claim 1,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a mathematical function.
13. (Previously amended) The system of claim 1,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a numeric value.
14. (Previously amended) The system of claim 1,

wherein said formula data are configured to be modified in response to business requirements of an insurance organization to form modified formula data.

15. (Previously amended) The system of claim 1,  
wherein said formula data are configured to be modified as a function of business requirements of an insurance organization to form modified formula data;  
wherein said translator program is configured to be modified as a function of business requirements of an insurance organization to form a modified translator program; and  
wherein said modified translator program is configured to read said modified formula data from said database and transform said modified formula data into a modified plurality of formulas.
16. (Original) The system of claim 1,  
wherein said formulas are usable in real-time by said plurality of rules to assess the value of the insurance claim.
17. (Original) The system of claim 1,  
wherein said insurance claim comprises a bodily injury claim, and wherein said value of said insurance claim comprises a bodily injury general damages value.
18. (Original) The system of claim 17,  
wherein said plurality of rules use said formulas to determine a trauma severity value associated with said bodily injury claim.
19. (Original) The system of claim 1, further comprising:  
a CPU;

a memory coupled to the CPU, wherein said rules engine comprises program instructions which are stored in said memory and executable by said CPU.

20. (Original) The system of claim 1,  
wherein said rules comprise logical instructions for assessing said value of said insurance claim.
21. (Original) The system of claim 1,  
wherein each rule comprises a premise and one or more resulting actions for assessing said value of said insurance claim.
22. (Original) The system of claim 1,  
wherein each of said formulas comprises one or more inputs and one or more functions operating on said one or more inputs to compute one or more outputs.
23. (Previously amended) A method comprising:  
providing a rules engine which is operable to assess a value of an insurance claim as a function of a plurality of rules, wherein said plurality of rules use formulas to assess said value of said insurance claim;  
providing a database which stores formula data, wherein said database is separate from said rules engine;  
reading said formula data from said database; and  
transforming said formula data into said formulas usable by said plurality of rules.
24. (Original) The method of claim 23,

wherein said insurance claim comprises a bodily injury claim, and wherein said value of said insurance claim comprises a bodily injury general damages value.

25. (Original) The method of claim 24, further comprising:  
assessing said value of said insurance claim as a function of said plurality of rules and said plurality of formulas by determining a trauma severity value associated with said bodily injury claim.
26. (Original) The method of claim 23,  
wherein said formula data is stored in a tabular format in said database.
27. (Original) The method of claim 23,  
wherein said rules engine comprises program instructions which are executable by a computer.
28. (Original) The method of claim 23,  
wherein said rules comprise logical instructions for assessing said value of said insurance claim.
29. (Original) The method of claim 23,  
wherein each rule comprises a premise and one or more resulting actions for assessing said value of said insurance claim.
30. (Original) The method of claim 23,  
wherein said formulas data comprises alphanumeric values stored in said database.

31. (Original) The method of claim 23, further comprising:  
updating said formulas by updating said formula data stored in said database.
32. (Original) The method of claim 23, further comprising:  
updating said formula data in said database;  
reading said updated formula data from said database; and  
transforming said updated formula data into updated formulas for use by said plurality of rules.
33. (Original) The method of claim 23, further comprising:  
modifying said formula data in response to business requirements of an insurance organization to form customized formula data.
34. (Original) The method of claim 33, further comprising:  
modifying said formulas to form modified formulas by using said modified formula data.
35. (Original) The method of claim 23,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a formula identifier.
36. (Original) The method of claim 23,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a sequence number.
37. (Original) The method of claim 23,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a section description.

38. (Original) The method of claim 23,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a page identifier.
39. (Original) The method of claim 23,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a prompt identifier.
40. (Original) The method of claim 23,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises an answer identifier.
41. (Original) The method of claim 23,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a mathematical function.
42. (Original) The method of claim 23,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a numeric value.
43. (Previously amended) A carrier medium comprising program instructions,  
wherein said program instructions are computer-executable to implement:  
providing a rules engine which is operable to assess a value of an insurance claim  
as a function of a plurality of rules, wherein said plurality of rules use  
formulas to assess said value of said insurance claim;  
accessing a database which stores formula data, wherein said database is separate  
from said rules engine;

reading said formula data from said database; and  
transforming said formula data into said formulas usable by said plurality of rules.

44. (Original) The carrier medium of claim 43,  
wherein said insurance claim comprises a bodily injury claim, and wherein said value of said insurance claim comprises a bodily injury general damages value.
45. (Original) The carrier medium of claim 44, wherein said program instructions are further computer-executable to implement:  
assessing said value of said insurance claim as a function of said plurality of rules and said plurality of formulas by determining a trauma severity value associated with said bodily injury claim.
46. (Original) The carrier medium of claim 43,  
wherein said formula data is stored in a tabular format in said database.
47. (Original) The carrier medium of claim 43,  
wherein said rules engine comprises program instructions which are executable by a computer.
48. (Original) The carrier medium of claim 43,  
wherein said rules comprise logical instructions for assessing said value of said insurance claim.
49. (Original) The carrier medium of claim 43,  
wherein each rule comprises a premise and one or more resulting actions for assessing said value of said insurance claim.

50. (Original) The carrier medium of claim 43,  
wherein said formulas data comprises alphanumeric values stored in said  
database.
51. (Original) The carrier medium of claim 43, wherein said program instructions are  
further computer-executable to implement:  
updating said formulas by updating said formula data stored in said database.
52. (Original) The carrier medium of claim 43, wherein said program instructions are  
further computer-executable to implement:  
updating said formula data in said database;  
reading said updated formula data from said database; and  
transforming said updated formula data into updated formulas for use by said  
plurality of rules.
53. (Original) The carrier medium of claim 43, wherein said program instructions are  
further computer-executable to implement:  
modifying said formula data in response to business requirements of an insurance  
organization to form modified formula data.
54. (Original) The carrier medium of claim 53, wherein said program instructions are  
further computer-executable to implement:  
modifying said formulas to form modified formulas by using said modified  
formula data.
55. (Original) The carrier medium of claim 43,

wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a formula identifier.

56. (Original) The carrier medium of claim 43,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a sequence number.
57. (Original) The carrier medium of claim 43,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a section description.
58. (Original) The carrier medium of claim 43,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a page identifier.
59. (Original) The carrier medium of claim 43,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a prompt identifier.
60. (Original) The carrier medium of claim 43,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises an answer identifier.
61. (Original) The carrier medium of claim 43,  
wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a mathematical function.
62. (Original) The carrier medium of claim 43,

wherein said formula data comprises a plurality of entries in said database,  
wherein at least one entry comprises a numeric value.

63. (Previously added) The system of claim 1,  
wherein said formula data are configured to be modified as a function of business  
requirements of an insurance organization to form modified formula data;  
and  
wherein said translator program is configured to read said modified formula data  
from said database and transform said modified formula data into a  
modified plurality of formulas.

**Response to Office Action Mailed April 18, 2003**

**A. Claims in the Case**

Claims 1-63 have been rejected. Claim 1 has been amended. Claims 1 and 3-63 are pending.

**B. The Claims Are Not Obvious Over McKee in View of Hammond Under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-63 as being obvious over U.S. Patent No. 6,272,482 to McKee et al. (hereinafter “McKee”) in view of U.S. Patent Application No. 5,613,072 to Hammond et al. (hereinafter “Hammond”) under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Claim 1 describes a combination of features including but not limited to the following features:

a rules engine which is operable to assess a value of an insurance claim as a function of a plurality of rules, wherein said plurality of rules comprise formulas to assess said value of said insurance claim;

a database which stores formula data, wherein said database is separate from said rules engine; and

a translator program which is operable to read said formula data from said database and transform said formula data into said formulas of said plurality of rules.

In rejecting claim 1, the Examiner states in part that:

McKee does not explicitly disclose wherein said database is separate from said rules engine; and a translator program which is operable to read formula data from said database and transform said formula data into said formulas of said plurality of rules. (Office Action, page 2).

Applicant agrees that McKee does not teach these features. The Examiner further states:

In particular, Hammond suggests wherein said database is separate from said rules engine (Col. 13, lines 54-67 to Col. 14, line 17); and a translator program which is operable to read formula data from said database and transform said formula data into said formulas of said plurality of rules (The Examiner interprets computer program as a form of translator which can update its records on its active workers' compensation claims 30 as a matter of course on a host computer 34 which is typically a multi-function main frame computer maintained by the carrier (Col. 3, lines 30-67 to Col. 4, line 67). (Office Action, pages 2-3)

Applicant respectfully disagrees with the Examiner that Hammond teaches a translator program as recited in claim 1. The Examiner cites Hammond:

The historical claim data 10 is analyzed and statistical techniques are applied to the data 10 to create statistical models 22 which are later used to predict future

costs and durations of the carrier's active workers' compensation claims. In this regard, a professional statistician 26 applies various statistical analysis techniques to the claim data 10 in order to create the statistical models 22. (Hammond, col. 3, lines 53-59)

Hammond specifically discloses a "professional statistician" creates "statistical models" from data stored on the system. First, claim 1 recites "a translator program", not a "professional statistician" as taught by Hammond. Second, the data in the database of Hammond is being manipulated to create "statistical models", not "formulas of said plurality of rules" as recited in claim 1. As stated in the Applicant's specification:

In one embodiment, the database 40 may include a plurality of tables, which may be accessed by a translator program, also referred to as an application program, to transform, create, generate, or instantiate the data stored in the tables into formulas. (Applicant's Specification, page 14, lines 20-22).

The Applicant's specification further states:

In another embodiment, the translator program may transform data stored in tables into static instances of an object class. In one embodiment, for example, the formula data table shown by way of example in Figure 3a includes data structured in tabular format, i.e., a table with several rows and columns. In one embodiment, the Formulas class of objects may include static instances wherein each static instance is a direct representation of a row of data in the formula data table. (Applicant's specification, page 14, line 26 – page 15, line 1).

The translator program disclosed in Applicant's specification reads formula data from the database and transforms the formula data into formulas of the plurality of rules. Hammond does not teach the formulas as recited in claim 1. Hammond teaches:

The review process is initiated in a step 140 by reading the historical file using a statistical applications program such as SAS. Procedures within SAS provide summary statistics for all variables in the file. The summary statistics produced by SAS include, but are not limited to, means, variances, correlations, minimums and maximums for continuous variables (e.g., dollar fields), and contingency tables (both one-way and multi-way) for discrete variables (e.g., BODY PART). (Hammond, col. 6, lines 29-37).

Hammond does not disclose "a translator program which is operable to read said formula data from said database and transform said formula data into said formulas of said plurality of rules" as recited in claim 1. Applicant respectfully requests the Examiner cite where in Hammond "a translator program which is operable to read said formula data from said database and transform said formula data into said formulas of said plurality of rules" is taught.

Furthermore, the Examiner has not stated a prima facie case of obviousness for why McKee and Hammond are combinable. As stated in the MPEP §2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

There is no suggestion or motivation in the references or in the knowledge generally available to combine the reference teachings. The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the feature of Hammond within the system of McKee with the motivation of providing a generated models which are installed onto a designated computer accessible by the insurance carrier. The insurance carrier maintains and updates its active workers' compensation claims on a host computer at the carrier facility (See Hammond Col. 2, lines 31-34).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), MPEP § 2143.01. Further, Applicant respectfully submits that whether or not "a particular combination might be 'obvious to try' is not a legitimate test of patentability." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988). McKee actually teaches away from using Hammond. For example, McKee teaches:

The foregoing objects are achieved in a method of managing a set of rules used by an application program running on a data processing system, generally comprising the steps of defining a plurality of jurisdictions to the control point. Multiple control points may be created for a given decision, and the mapping step maps different sets of rules to the respective control points. The mapping step may map rules to a given control point from a number of the jurisdictions which is less than the entire number of jurisdictions, i.e., it is possible that not all jurisdictions have rules mapped to a particular control point. (McKee, col. 2, lines 54-67).

McKee teaches the jurisdictions are “any authority who wishes to assert control over a set of business decisions (McKee, col. 3, lines 61-62).” In addition, McKee teaches that “jurisdictions may be interrogated to inquire if they have any business rules that they wish to apply to an object (McKee, col. 4, lines 3-4).” In contrast, Hammond teaches:

Periodically, the carrier will apply the statistical models to its active claims to obtain cost and duration predictions by downloading a file containing active claim data to the designated computer.

In applying the models, the significant characteristics of each active claim are analyzed by an appropriate model to generate a cost and duration prediction for each such claim. (Hammond, col. 2, lines 35-42).

There is no teaching or motivation, either in the references themselves or in the prior art to incorporate the statistical models of Hammond with the decision/control point/jurisdiction structure of McKee. Furthermore, the statistical models of Hammond are applied to “each active claim (Hammond, col. 2, line 41).” McKee, however, teaches “a set of rules used by an application program running on a data processing system, generally comprising the steps of defining a plurality of jurisdictions adapted to exert authority over a decision of the application program (emphasis added) (McKee, col. 2, lines 55-58).” The teaching of Hammond does not appear to apply to the decisions of McKee.

Claim 23 describes a combination of features including but not limited to the following features:

providing a rules engine which is operable to assess a value of an insurance claim as a function of a plurality of rules, wherein said plurality of rules use formulas to assess said value of said insurance claim;

providing a database which stores formula data, wherein said database is separate from said rules engine;  
reading said formula data from said database; and  
transforming said formula data into said formulas usable by said plurality of rules.

For at least the reasons discussed in reference to claim 1, Applicant submits that the combination of McKee and Hammond does not appear to teach or suggest all of the features of Applicant's claim 23.

Claim 43 describes a combination of features including but not limited to the following features:

providing a rules engine which is operable to assess a value of an insurance claim as a function of a plurality of rules, wherein said plurality of rules use formulas to assess said value of said insurance claim;  
accessing a database which stores formula data, wherein said database is separate from said rules engine;  
reading said formula data from said database; and  
transforming said formula data into said formulas usable by said plurality of rules.

For at least the reasons discussed in reference to claim 1, Applicant submits that the combination of McKee and Hammond does not appear to teach or suggest all of the features of Applicant's claim 43.

**C. Many Of The Dependent Claims Are Separately Patentable**

The Examiner is also respectfully requested to separately consider each of the dependent claims for patentability. Many of the dependent claims in addition to those mentioned above are independently patentable.

For instance, claim 6 recites in part “wherein said formula data comprises a plurality of entries in said database, wherein at least one entry comprises a formula identifier.” Applicant submits that this feature, in combination with the features of the independent claims, does not appear to be taught or suggested by the cited art. The Examiner cites Hammond for this teaching:

Assuming a sufficient amount of available raw claim data, in a step 164, the program randomly divides each of the INJURY TYPE specific subfiles into two groups; one data subset is for model development and the other data subset is for model accuracy assessment. (Hammond, col. 8, lines 8-12).

Hammond does not appear to teach “at least one entry comprises a formula identifier” as recited in claim 6.

In addition, claim 8 recites in part “wherein said formula data comprises a plurality of entries in said database, wherein at least one entry comprises a section description.” Applicant submits that this feature, in combination with the features of the independent claims, does not appear to be taught or suggested by the cited art. The Examiner cites McKee for this teaching:

Many older business applications contain rudimentary business rules inherent in the program control logic. However, since these applications cannot adjust to the dynamically changing business conditions, the flexibility of such business rules is severely limited. More recently, an alternative approach has been formulated, which allows developers to create modular business rules, and allows business experts to specify rule parameters using a high-level business rules language. Another approach is to use object-oriented systems to encapsulate the “rules” using a strategy pattern (or method template) from a pattern book. This approach

is not dynamic and requires code changes to implement. (McKee, col. 2, lines 8-20)

McKee does not appear to teach a “database, wherein at least one entry comprises a section description” as recited in claim 8. McKee appears to teach “modular business rules” and “strategy pattern(s),” but McKee does not appear to teach databases or section descriptions in a database.

In addition, claim 9 recites in part “wherein said formula data comprises a plurality of entries in said database, wherein at least one entry comprises a page identifier.” Applicant submits that this feature, in combination with the features of the independent claims, does not appear to be taught or suggested by the cited art. The Examiner has cited the same passage from McKee for this teaching as the Examiner cited respective to claim 8. McKee does not appear to teach databases or page identifiers in a database.

Furthermore, claim 15 recites in part:

wherein said formula data are configured to be modified as a function of business requirements of an insurance organization to form modified formula data;  
wherein said translator program is configured to be modified as a function of business requirements of an insurance organization to form a modified translator program;  
and

wherein said modified translator program is configured to read said modified formula data from said database and transform said modified formula data into a modified plurality of formulas.

Applicant submits that this feature, in combination with the features of the independent claims, does not appear to be taught or suggested by the cited art. The Examiner states:

As per claim 15, McKee discloses the system wherein said formula data are configured to be modified as a function of business requirements of an insurance organization to form modified formula data (Col. 3, lines 44-67); wherein said translator program is configured to be modified as a function to of business requirements of an insurance organization to form a modified translator program (Col. 5, lines 32-52); and wherein said modified translator program is configured to read said modified formula data from said database and transform said modified formula data into a modified plurality of formulas (Col. 5, lines 32-52).  
(Office Action, page 5)

McKee appears to teach the use of “rules (McKee, col. 5, line 40),” not “formula data” as recited in claim 15. Furthermore, even if the “rules” of McKee were formula data, McKee does not appear to teach forming “modified formula data” as recited in claim 15. Instead, McKee teaches “subsetting a large set of business rules (McKee, Col. 3, lines 50-51).” In addition, McKee does not appear to teach forming “a modified translator program” or reading “said modified formula data from said database and transform said modified formula data into a modified plurality of formulas” as recited in claim 15.

D. Summary

In light of the foregoing remarks, Applicant submits the application is now in condition for allowance, and an early notice to that effect is requested.

No fees are believed necessary; however, the Commissioner is authorized to charge any fees which may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 50-1505\5053-27900\EBM.

Respectfully submitted,



Mark R. DeLuca  
Reg. No. 44,649

Patent Agent for Applicant (s)

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.  
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(512) 853-8801 (facsimile)

Date: 6/18/03

Inventor: Wolfe et al.  
U.S. Pat. Appl. No.: 09/603,308

bcc: Paul Stanfield, Esq. (w/encl.)  
Ken Purcell, Esq. (w/encl.)



UNITED STATES PATENT AND TRADEMARK OFFICE

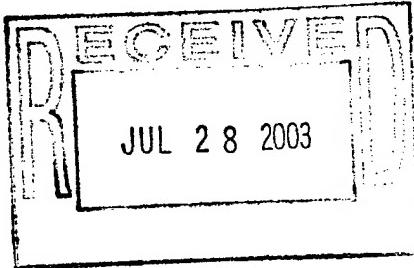
*Exhibit B*

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,308	06/23/2000	Brian Wolfe	5053-27900	1777

7590                    07/22/2003

Eric B Meyertons  
Conley Rose & Tayon PC  
PO Box 398  
Austin, TX 78767-0398



EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Attorney: *Aldusong, Aetos*  
Transfer:  
Action: *Advisory Action*  
Due: *7/18/03*  
Docketed: *7/28*

<b>Advisory Action</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/603,308	vWOLFE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Vanel Frenel	3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 23 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- 2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

- 3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
- 4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet..
- 6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-62.

Claim(s) withdrawn from consideration: None.

- 8.  The proposed drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.

- 9.  Note the attached Information Disclosure Statement(s) ( PTO-1449) Paper No(s). \_\_\_\_\_.

- 10.  Other: \_\_\_\_\_

JOSEPH THOMAS

SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800  
U.S. Patent and Trademark Office  
PTO-303 (Rev. 04-01)

## Continuation Sheet (PTO-303)

Copnintuation of 5:

Applicant's request for consideration does not place the application in condition for allowance because: Applicant arguments filed 06/23/03 with respect to claims 1-63 are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 06/23/03.

(A) (1) At pages 13-22 of the 06/23/03 response, Applicant argues that the Examiner has the burden of establishing a prima facie case of obviousness; (2) Applicant argues that McKee does not disclose "wherein said database is separate from said rule engine; and a translator program which is operable to read formula data from said database and transform said formula data into said formulas of said plurality of rules; (3) Hammond does not disclose "formulas of said plurality of rules"; (4) There is no suggestion or motivation in the references or in the knowledge generally available to combine the reference teachings; Hammond does not appear to teach "at least one entry comprises a formula identifier" (5) McKee does not appear to teach databases or page identifiers in a database and McKee does not appear to teach "modified formula data" and "modified translator program" or "reading" said modified formula data from said database and transform said modified formula data into a modified plurality of formulas"

In response to Aplicant's first argument, Examiner respectfully suggests one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In RE Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's second argument, Examiner respectfully suggests that McKee discloses "business information system includes a multitude of interconnected computers, printers, scanners, communications equipment, and other peripheral devices, allowing the business to automate much of the processing of its business information (See McKee, Col.1, lines 15-67 to Col.2, line 40).

In response to Applicant's third argument, Examiner respectfully suggests that McKee discloses "business rules might be used to assist in various business decisions, such as whether to increase (or decrease) staffing, how many resources to allocate to a particular project, or when to introduce a new product to the market (See McKee, Col.1, lines 38-57). Furthermore, McKee discloses "an alternative approach has been formulated, which allows developers to create modular business rules, and allows business experts to specify rule parameters using a high-level business rules language (See McKee, Col.2, lines 12-16). Therefore, Applicant's argument is not persuasive.

In reponse to Aplicant's fourth argument, Examiner respectfully suggests that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); In re Piaseckii, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of coreponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 5). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, Ex parte Levengood, 28 USPQ2d 1300(Bd. Pat. App. & Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained. In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

In response to Applicant's fifth argument, Examiner respectfully suggests that McKee discloses "network adapter may be used to connect data processing system 20 to a local area network 94. Network 94 may provide computer users with means of communicating and transferring software and information electronically. Additionally, network 94 may provide distributed processing, which involves several computers in the sharing of workloads or cooperative efforts in performing a task (which the Examiner interprets as "modified formula data" and "modified translator program" or "reading" See McKee, Col.7, lines 20-35). Therefore, Applicant's argument is not persuasive.

*(Exhibit C)*  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/603,308  
Confirmation No. 1777  
Filed: June 23, 2000  
Inventor(s):  
Wolfe et al.

Title: SYSTEM AND METHOD  
FOR EXTERNALIZATION  
OF FORMULAS FOR  
ASSESSING DAMAGES

§ Examiner: Frenel, Vanel  
§ Art Unit: 3626  
§ Atty. Dkt. No: 5053-27900

CERTIFICATE OF MAILING  
UNDER 37 C.F.R. § 1.8

DATE OF DEPOSIT: 8-18-03

I hereby certify that this correspondence is being deposited with  
the United States Postal Service with sufficient postage as first  
class mail on the date indicated above and is addressed to:

Commissioner for Patents  
Alexandria VA 22313

*B. Gail Ballard*  
B. Gail Ballard

REQUEST FOR CONTINUED EXAMINATION  
REQUEST TRANSMITTAL  
(under 37 CFR § 1.114)

This is a request for continued examination under 37 C.F.R. § 1.114 of application number 09/603,308, filed on June 23, 2000, entitled SYSTEM AND METHOD FOR EXTERNALIZATION OF FORMULAS FOR ASSESSING DAMAGES.

Inventors(s): Brian Wolfe and Allison W. Spann

Examiner: Frenel, Vanel Art Unit: 3626

Assignee: Computer Sciences Corporation Recorded at Reel 011206, Frame 0521

Correspondence Address in Prior Application:  
Eric B. Meyertons  
Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.  
P.O. Box 398  
Austin, Texas 78767-0398

Application Elements

1.  Filing Fee A Fee Authorization Form authorizing a deposit account debit for the RCE fee (\$750.00) required under 37 C.F.R. § 1.17(e) is enclosed.
2.  Information Disclosure Statement (IDS)
  - Copies of IDS Citations
  - Form(s) PTO-1449 (1 page)
3. Amendments

An amendment is enclosed.

- Enter the unentered amendment previously filed on \_\_\_\_\_ under 37 C.F.R. § 1.116.
- Please consider the arguments in the response filed on \_\_\_\_\_ under 37 C.F.R. § 1.116.
- Please consider the arguments in the Appeal Brief or Reply Brief filed on \_\_\_\_\_.

Wolfe et al.

4.  Please enter the enclosed affidavits or declarations.
5.  Return Receipt Postcard
6.  Petition under 37 C.F.R. § 1.136 for Extension of Time
7.  Other: \_\_\_\_\_

New Correspondence address

Eric B. Meyertons  
Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.  
P.O. Box 398  
Austin, Texas 78767-0398  
Phone: (512) 853-8800 Fax: (512) 853-8801

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions.

The Commissioner is hereby authorized to charge any other fees which may be required or credit any overpayment to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C., Deposit Account No. 50-1505/5053-27900/EBM.

One duplicate copy of this form is enclosed.

Signature



Name

Mark R. DeLuca

Registration No.

44,649

Date

8 / 18 / 03

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/603,308

Confirmation No. 1777

Filed: June 23, 2000

Inventor(s):

Brian Wolfe

Allison W. Spann

Title: SYSTEM AND METHOD  
FOR EXTERNALIZATION  
OF FORMULAS FOR  
ASSESSING DAMAGES

§ Examiner: Frenel, Vanel

§ Art Unit: 3626

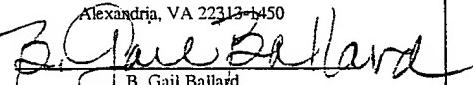
§ Atty. Dkt. No: 5053-27900/EBM

CERTIFICATE OF EXPRESS MAIL  
UNDER 37 C.F.R. §1.10

"Express Mail" mailing label number:  
DATE OF DEPOSIT: 8-18-03

I hereby certify that this paper or fee is being deposited with the  
United States Postal Service "Express Mail Post Office to  
Addressee" service under 37 C.F.R. §1.10 on the date indicated  
above and is addressed to:

Commissioner for Patents  
Alexandria, VA 22313-1450

  
B. Gail Ballard

FEE AUTHORIZATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

The Commissioner is hereby authorized to charge the following fees to Meyertons, Hood, Kivlin,  
Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-27900/EBM

\$750.00 – Request for Continued Examination

Total Amount: \$750.00

Attorney Docket No.: 5053-27900

Wolfe et al.  
09/603,308

The Commissioner is also authorized to charge any extension fee or other fees which may be necessary to the same account number.

Respectfully submitted,



Mark R. DeLuca  
Reg. No. 44,649

Patent Agent for Applicant

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.  
P.O. BOX 398  
AUSTIN, TX 78767-0398  
(512) 853-8800 (voice)  
(512) 853-8801 (facsimile)

Date: 8/18/03

*(Exhibit D)*

*RECEIVED*

JAN 05 2004

*GROUP 300*

COMMISSIONER OF PATENTS AND TRADEMARKS ALEXANDRIA, VA

Inventor: Brian Wolfe and Allison Spann  
 Assignee: Computer Sciences Corporation  
 Title: SYSTEM AND METHOD FOR EXTERNALIZATION OF  
       FORMULAS FOR ASSESSING DAMAGES  
 Serial No.: 09/603,308  
 Attorney Docket No.: 5053-27900/EBM

The date stamp of the mail room of the U.S. Patent and Trademark Office hereon will acknowledge receipt of the following:

- 2 page(s) Request for Continued Examination Request Transmittal  
2 page(s) Fee Authorization  
X Return Postcard

EBM:bgb

Via First Class Mail

Date: *8-18-03*

COMMISSIONER OF PATENTS AND TRADEMARKS ALEXANDRIA, VA

Inventor: Brian Wolfe and Allison Spann  
 Assignee: Computer Sciences Corporation  
 Title: SYSTEM AND METHOD FOR EXTERNALIZATION OF  
       FORMULAS FOR ASSESSING DAMAGES  
 Serial No.: 09/603,308  
 Attorney Docket No.: 5053-27900/EBM

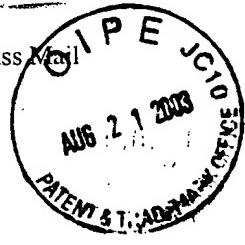
The date stamp of the mail room of the U.S. Patent and Trademark Office hereon will acknowledge receipt of the following:

- 2 page(s) Request for Continued Examination Request Transmittal  
2 page(s) Fee Authorization  
X Return Postcard

EBM:bgb

Via First Class Mail

Date: *8-18-03*



*Exhibit E*

UNITED STATES PATENT AND TRADEMARK OFFICE ACKNOWLEDGEMENT RECEIPT	
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Electronic Version 1.1

Stylesheet Version v1.1.1

Title of Invention	System and Method for Externalization of Formulas for Assessing Damages																									
Submission Type:	Information Disclosure Statement																									
Application Number:	09/603308	*09/603308*																								
EFS ID:	45954																									
Server Response:	<table border="1"><thead><tr><th>Confirmation Code</th><th>Message</th></tr></thead><tbody><tr><td>ISVR1</td><td>Submission was successfully submitted - Even if Informational or Warning Messages appear below, please do not resubmit this application</td></tr><tr><td>ICON1</td><td>1777</td></tr><tr><td>ISYS5</td><td>Filename= N/A BusinessRule= Validation System/Function Call Information. #Supporting Msg: Server unable to validate the Confirmation/Application numbers at this time. They will be checked by PTO personnel later.</td></tr></tbody></table>		Confirmation Code	Message	ISVR1	Submission was successfully submitted - Even if Informational or Warning Messages appear below, please do not resubmit this application	ICON1	1777	ISYS5	Filename= N/A BusinessRule= Validation System/Function Call Information. #Supporting Msg: Server unable to validate the Confirmation/Application numbers at this time. They will be checked by PTO personnel later.																
Confirmation Code	Message																									
ISVR1	Submission was successfully submitted - Even if Informational or Warning Messages appear below, please do not resubmit this application																									
ICON1	1777																									
ISYS5	Filename= N/A BusinessRule= Validation System/Function Call Information. #Supporting Msg: Server unable to validate the Confirmation/Application numbers at this time. They will be checked by PTO personnel later.																									
First Named Applicant:	Brian Wolfe																									
Attorney Docket Number:	5053-27900																									
Timestamp:	2003-08-19 15:06:12 EDT																									
From:	us																									
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Doc. Name	File Name	Size (Bytes)																								
us-ids	template-usidst.xml	16700																								
us-ids	us-ids.dtd	7763																								
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Digital Certificate Holder Name:	cn=Eric B. Meyertons,ou=Registered Attorneys,ou=Patent and Trademark Office,ou=Department of Commerce,o=U.S.																									

Government,c=US

# ELECTRONIC INFORMATION DISCLOSURE STATEMENT

Electronic Version v18

Stylesheet Version v18.0

Title of Invention	System and Method for Externalization of Formulas for Assessing Damages							
Application Number:	09/603308			*09/603308*				
Confirmation Number:	1777							
First Named Applicant:	Brian Wolfe							
Attorney Docket Number:	5053-27900							
Art Unit:	3626							
Examiner:	Unknown Unknown							
Search string:	( 4553206 or 4812966 or 4837693 or 4878167 or 4987538 or 4992972 or 5093911 or 5099422 or 5155806 or 5157768 or 5191522 or 5201044 or 5233513 or 5287448 or 5307262 or 5307265 or 5386566 or 5394555 or 5434994 or 5455947 or 5471575 or 5481667 or 5483632 or 5499330 or 5504675 or 5517405 or 5550976 or 5638508 or 5644778 or 5652842 or 5655085 or 5689706 or 5717913 or 5745901 or 5748953 or 5768505 or 5768506 or 5768578 or 5797134 or 5832481 or 5832530 or 5835897 or 5835914 or 5850442 or 5870711 or 5873066 or 5884274 or 5895461 or 5899998 or 5907848 or 5909683 or 5918208 or 5930759 or 5933816 or 5937189 or 5950196 or 5987434 or 5991733 or 5991756 or 5999940 or 6012053 or 6029195 or 6038393 or 6038668 or 6049665 or 6061657 or 6064983 or 6065047 or 6073104 or 6081832 or 6088710 or 6092049 or 6105007 or 6112986 or 6115690 or 6134582 or 6148297 or 6163770 or 6185540 or 6226623 or 6236975 or 6239798 or 6266645 or 6272471 or 6272528 or 6336096 or 6370511 or 6456303 or 6484178 or 5535323 or 5586310 or 20020116228 ).pn.							
<b>US Patent Documents</b>								
Note: Applicant is not required to submit a paper copy of cited US Patent Documents								
init	Cite.No.	Patent No.	Date	Patentee	Kind	Class	Subclass	
	1	4553206	1985-11-12	Smutek et al.				
	2	4812966	1989-03-14	Takagi et al.				
	3	4837693	1989-06-06	Schotz				
	4	4878167	1989-10-31	Kapulka et al.				

	5	4987538	1991-01-22	Johnson et al.
	6	4992972	1991-02-12	Brooks et al.
	7	5093911	1992-03-03	Parks et al.
	8	5099422	1992-03-24	Foresman et al.
	9	5155806	1992-10-13	Hoeber et al.
	10	5157768	1992-10-20	Hoeber et al.
	11	5191522	1993-03-02	Bosco et al.
	12	5201044	1993-04-06	Frey, Jr. et al.
	13	5233513	1993-08-03	Doyle
	14	5287448	1994-02-15	Nicol et al.
	15	5307262	1994-04-26	Ertel
	16	5307265	1994-04-26	Winans
	17	5386566	1995-01-31	Hamanaka et al.
	18	5394555	1995-02-28	Hunter et al.
	19	5434994	1995-07-18	Shaheen et al.
	20	5455947	1995-10-03	Suzuki et al.
	21	5471575	1995-11-28	Giansante
	22	5481667	1996-01-02	Bieniek et al.
	23	5483632	1996-01-09	Kuwamoto et al.
	24	5499330	1996-03-12	Lucas et al.
	25	5504675	1996-04-02	Cragun et al.
	26	5517405	1996-05-14	McAndrew et al.
	27	5550976	1996-08-27	Henderson et al.
	28	5638508	1997-06-10	Kanai et al.
	29	5644778	1997-07-01	Burks et al.
	30	5652842	1997-07-29	Siegrist, Jr. et al.
	31	5655085	1997-08-05	Ryan et al.
	32	5689706	1997-11-18	Rao et al.
	33	5717913	1998-02-10	Driscoll
	34	5745901	1998-04-28	Entner et al.
	35	5748953	1998-05-05	Mizutani et al.
	36	5768505	1998-06-16	Gilchrist et al.
	37	5768506	1998-06-16	Randell
	38	5768578	1998-06-16	Kirk et al.
	39	5797134	1998-08-18	McMillan et al.
	40	5832481	1998-11-03	Sheffield

	41	5832530	1998-11-03	Paknad et al.
	42	5835897	1998-11-10	Dang
	43	5835914	1998-11-10	Brim
	44	5850442	1998-12-15	Muftic
	45	5870711	1999-02-09	Huffman
	46	5873066	1999-02-16	Underwood et al.
	47	5884274	1999-03-16	Walker et al.
	48	5895461	1999-04-20	De La Huerga et al.
	49	5899998	1999-05-04	McGauley et al.
	50	5907848	1999-05-25	Zaiken et al.
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	52	5918208	1999-06-29	Javitt
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	90	5535323	1996-07-09	Miller et al.
	91	5586310	1996-12-17	Sharman

## US Published Applications

Note: Applicant is not required to submit a paper copy of cited US Published Applications

init	Cite.No.	Pub. No.	Date	Applicant	Kind	Class	Subclass
	1	20020116228	2002-08-22	Bauer et al.			

## Remarks

Note: Remarks are not for responding to an office action.

Additional non-patent references are being sent by mail.

## Signature

Examiner Name	Date

*Exhibit F*

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/603,308

Confirmation No. 1777

Filed: June 23, 2000

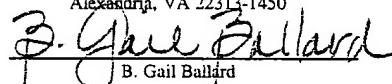
Inventor(s):

Brian Wolfe

Allison W. Spann

Title: SYSTEM AND METHOD  
FOR EXTERNALIZATION  
OF FORMULAS FOR  
ASSESSING DAMAGES

§ Examiner: Frenel, Vanel.  
§ Art Unit: 3626  
§ Atty. Dkt. No: 5053-27900

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8	
DATE OF DEPOSIT: 8-20-03	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail on the date indicated above and is addressed to: Commissioner for Patents Alexandria, VA 22313-1450	
 B. Gail Ballard	

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

It is respectfully requested that this Information Disclosure Statement be entered and the documents listed on attached Form PTO-1449 be considered by the Examiner and made of record. Copies of the listed documents are enclosed for the convenience of the Examiner. Applicant respectfully requests that the Examiner also consider the following U.S. Patent applications:

US Patent Application 09/603,307 (5053-27600);

US Patent Application 09/603,129 (5053-27700);

US Patent Application 09/603,144 (5053-28000);

US Patent Application 09/602,687 (5053-28100);

US Patent Application 09/603,662 (5053-27800);

US Patent Application 09/603,302 (5053-35700)\* - Claims Only, Specification

and Figures are similar to US Patent Application 09/603,662 (5053-27800);

US Patent Application 09/602,691 (5053-35800)\* - Claims Only, Specification

and Figures are similar to US Patent Application 09/603,662 (5053-27800);

US Patent Application 09/603,130 (5053-35900);

US Patent Application 09/603,303 (5053-36000);

US Patent Application 09/603,304 (5053-36100);

US Patent Application 09/603,306 (5053-36200);

US Patent Application 10/285,292 (5053-57800);

US Patent Application 10/285,289 (5053-57801)\* - Claims Only, Specification

and Figures are similar to US Patent Application 10/285,292 (5053-57800);

US Patent Application 10/285,339 (5053-57802)\* - Claims Only, Specification

and Figures are similar to US Patent Application 10/285,292 (5053-57800);

US Patent Application 10/285,375 (5053-57803)\* - Claims Only, Specification

and Figures are similar to US Patent Application 10/285,292 (5053-57800);

US Patent Application 10/285,338 (5053-57804)\* - Claims Only, Specification

and Figures are similar to US Patent Application 10/285,292 (5053-57800);

Wolfe, et al.  
09/603,308

US Patent Application 10/285,293 (5053-57805)\* - Claims Only, Specification

and Figures are similar to US Patent Application 10/285,292 (5053-57800);

US Patent Application 10/422,632 (5053-63000);

US Patent Application 10/422,450 (5053-63100)\* - Claims Only, Specification

and Figures are similar to US Patent Application 10/422,632 (5053-63000).

Should any fees be required, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 50-1505/5053-27900/EBM.

Respectfully submitted,

Eric B. Meyertons  
Reg. No. 34,876

Attorney for Applicant(s)

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.  
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(512) 853-8801 (facsimile)

Date: 8-20-03

<b>Form PTO-1449 (modified)</b> List of Patents and Publications For Applicant's Information Disclosure Statement (Use several sheets if necessary)	ATTY. DKT. NO. 5053-27900  APPLICANT: Wolfe, et al.  FILING DATE: June 23, 2000	SERIAL NO. 09/603,308  GROUP: 3626
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### U.S. PATENT DOCUMENTS

EXAM. INITIALS	REF. DES.	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE APPROPRIAT

### FOREIGN PATENT DOCUMENTS

EXAM. INITIALS	REF. DES.	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATIO YES/NO
	E1	0 280 773	09/1988	EP			
	E2	0 465 018	01/1992	EP			
	E3	0 926 608	06/1999	EP			

### OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

	F1	"@ Fault A Commitment to Consistency," Computer Sciences Corporation, Copyright 2000, pp. 1-2.
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	F13	Merlin, Jr., William F., "Colossus: What We Know Today," The Merlin Law Group, August 2000, Tampa, FL, pp. 1-8

EXAMINER:

DATE CONSIDERED:

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the patent owner

<b>Form PTO-1449</b> (modified) List of Patents and Publications For Applicant's Information Disclosure Statement (Use several sheets if necessary)		ATTY. DKT. NO. 5053-27900  APPLICANT: Wolfe, et al.  FILING DATE: June 23, 2000	SERIAL NO. 09/603,308  GROUP: 3626				
<b>U.S. PATENT DOCUMENTS</b>							
EXAM. INITIALS	REF. DES.	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE APPROPRIAT
<b>OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)</b>							
	F14	https://www.foremost.com/secure/fm_claims.htm 1996					
	F15	Summary of Colossus Functionality as of December 1999					

EXAMINER:

DATE CONSIDERED:

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the patent owner

# Exhibit G

RECEIVED  
JAN 05 2004  
CPT 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Inventor(s): Wolfe et al.  
Serial No.: 09/603,308  
Filing Date: June 23, 2000  
Title: SYSTEM AND METHOD FOR EXTERNALIZATION OF FORMULAS FOR ASSESSING DAMAGES  
Atty. Docket No.: 5053-27900

The date stamp of the mail room of the U.S. Patent and Trademark Office hereon will acknowledge receipt of the attached 1) Information Disclosure Statement (2 pgs); 2) Form PTO 1449 (2 pg) w/references E1-E3, F1-F15; and; 3) Return Postcard.

8-20-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Inventor(s): Wolfe et al.  
Serial No.: 09/603,308  
Filing Date: June 23, 2000  
Title: SYSTEM AND METHOD FOR EXTERNALIZATION OF FORMULAS FOR ASSESSING DAMAGES  
Atty. Docket No.: 5053-27900



The date stamp of the mail room of the U.S. Patent and Trademark Office hereon will acknowledge receipt of the attached 1) Information Disclosure Statement (2 pgs); 2) Form PTO 1449 (2 pg) w/references E1-E3, F1-F15; and; 3) Return Postcard.

EBM\bgb

Via First Class Mail

Date: 8-20-03



UNITED STATES PATENT AND TRADEMARK OFFICE

Exhibit A

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,308	06/23/2000	Brian Wolfe	5053-27900	1777

7590                    08/28/2003

Eric B Meyertons  
Conley Rose & Tayon PC  
PO Box 398  
Austin, TX 78767-0398

[REDACTED] EXAMINER

FRENEL, VANEL

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

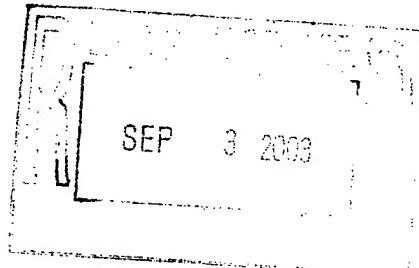
3626

DATE MAILED: 08/28/2003

Improper RCE

9/18/03  
9/3

Please find below and/or attached an Office communication concerning this application or proceeding.





Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NUMBER FILING DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

DATE MAILED:

**NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)**

The request for continued examination (RCE) under 37 CFR 1.114 filed on 8-21-03 is improper for reason(s) indicated below:

- 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d). An RCE cannot be treated as a CPA.
- 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b).
- 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.
- 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).
- 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on \_\_\_\_\_. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.
- 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
- 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

**Note:** A continued prosecution application (CPA) under 37 CFR 1.53(d) cannot be filed in a utility or plant application. A CPA filed in a utility or plant application that has a filing date on or after June 8, 1995 will be treated as an RCE under 37 CFR 1.114. The request for a CPA in the instant application, however, has been treated as an improper RCE for the reason(s) indicated above.

**A copy of this notice MUST be returned with any reply.**

Direct the reply and any questions concerning this notice to:

Lorraine Ellis, Technology Center 3600  
(703) 306-0423